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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/163,588    09/30/98    JONES

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PM82/0907  
SCOTT A HORSTEMEYER  
THOMAS KAYDEN HORSTEMEYER & RISLEY  
100 GALLERIA PARKWAY M W SUITE 1500  
ATLANTA GA 30339-5948

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EXAMINER

LOUIS JACQUES, J

ART UNIT	PAPER NUMBER
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3661

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DATE MAILED: 09/07/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/163,588

Applicant(s)

JONES, MARTIN KELLY

Examiner

Jacques H. Louis-Jacques

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2000.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13, 14, 16-23, 27-32, 35-39 and 41-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13, 14, 16-23, 27-32, 35-39 and 41-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) \_\_\_\_\_.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7, 8.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Response to Amendment***

1. The cancellation of claims 12, 15, 24-26, 33-34 and 40 and the addition of new claims 41-55 have been acknowledged. Accordingly, claims 1-11, 13-14, 16-23, 27-32m 35-39 and 41-55 are presented for consideration and examination.

### ***Continuation Data***

2. Application asserted that "the present application claims priority to copending US application No. 08/852,119. Further, application No.08/852,119 claims priority to U.S. Patent No. 5,623,260; 5,657,010, and 5,668,543." However, the record does not show such claim.

The record shows that the present application 09/163,958 claims priority, as a continuation-in-part, to US application No. 08/852,119. US Patent Nos. 5,623,260; 5657,010; and 5,668, 543 are all continuation-in-part of US Patent No. 5,400,020. There is no relationship between US application 08/852,119 and the above mentioned US patents. However, if applicant has documents (proof) to show otherwise, applicant is invented to submit such for consideration since US application No. 08/852,119 is under appeal and is with the Board of Appeals.

Accordingly, the double patenting rejections are sustained and the rejections are being reproduced below.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

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improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-11, 13-14, 16-23, 27-32m 35-39 and 41-55 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-30 of copending Application No. 09/395,497. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

5. Claims 1-11, 13-14, 16-23, 27-32m 35-39 and 41-55 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-36 of copending Application No. 09/163,958. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

6. Claims 1-11, 13-14, 16-23, 27-32m 35-39 and 41-55 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-21, 23-49 of copending Application

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No. 08/852,119. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending applications and would be covered by any patent granted on those copending applications since the referenced copending applications and the instant application are claiming common subject matter, as follows: A method for monitoring travel of vehicles and for reporting status of vehicles based on travel data related to the vehicles.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

7. Claims 1-11, 13-14, 16-23, 27-32m 35-39 and 41-55 are rejected under the judicially created doctrine of double patenting over claims 1-16 of U. S. Patent No. 5,623,260 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

8. Claims 1-11, 13-14, 16-23, 27-32m 35-39 and 41-55 are rejected under the judicially created doctrine of double patenting over claims 1-15 of U. S. Patent No. 5,657,010 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

9. Claims 1-11, 13-14, 16-23, 27-32m 35-39 and 41-55 are rejected under the judicially created doctrine of double patenting over claims 1-80 of U. S. Patent No. 5,668,543 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patents and is covered by the patents since the patents and the application are claiming common subject

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matter, as follows: An advance notification system and method utilizing passenger calling report generator.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-11, 13-14, 16-23, 27-32m 35-39 and 41-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ross [5,648,770] in view of Bolger [5,168,451].

Ross '770 discloses an apparatus and method of notifying a party of a pending delivery or pickup. A mobile receiver or carrier is equipped with a satellite receiver, a controller and a communicator. The position of the vehicle is determined based on positioning data or signals. The controller compares the current vehicle location or position to the location in the mapped area. The communicator then communicates with the user to notify user. As shown in figure 1, there are provided controllers (10 and 21), a video screens or computer displays (14 and 26). Ross '770 also discloses a storage device for storing travel data related to the vehicle. The storage device is mounted on the vehicle

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located at a remote location. There is also provided a communications device or apparatus for transmitting a message to a controller located at another remote location. The received or transmitted message is indicative of the status (proximity) of the vehicle. As disclosed in column 2, there is provided an analyzer for evaluating the positioning signals to determine the position of the carrier, the position of the carrier is compared with a predetermined location. Also, a time interval is computed, and when the time interval is less than a predetermined time interval, a signal is communication to provide reasonable advance notice. See column 2. Also, a message or notification is forwarded to user via a telephone associated therewith. See columns 5 and 6. As explained, more specifically in the claim section, Ross discloses a voice generator for generating or producing an audible message to notify the party. Ross discloses the time period, and the predetermined distance as the data representative of the proximity of the vehicle. In column 3, Ross '770 discloses the cellular network as a communications device. Further in column 3, Ross '700 discloses the vehicle indicator (identification) and the location indicator. Still in column 3, Ross '770 discloses the communication interface as being telephone interface devices. As an alternate embodiment of the Ross patent, the vehicle can bus a bus and the location indicator is a bus stop. See column 6. However, Ross '770 does not specifically teach that the user requests is for a specific or particular vehicle, i.e., the request identifying one of the vehicles and a location. Bolger, on the other hand, discloses a user responsive transit system, wherein a user requests information about a specific vehicle of a plurality of fleet vehicles. Based on the user request, a central dispatch controller accesses a database and receives information about the requested

vehicle. As shown in figure 7, there are provided a request terminal location (95), a destination location (96) coupled to a service request. As set forth in the specification, the system according to Bolger activates in response to service requests from users. See for example column 3. Thus, it would have been obvious to one skilled in the art at the time of the invention to be motivated to modify the teachings of Ross by incorporating the features from the user responsive transit system of Bolger because such modification will improve “flexibility and efficiency” of the system.

#### ***Response to Arguments***

12. Applicant's arguments filed on August 4, 2000 have been fully considered but they are not persuasive.

Applicant, in citing *Applied Materials Inc. v. Gemini Research Corp*<sup>1</sup>, *In re DeBaun*<sup>2</sup>, MPEP 2136.05<sup>3</sup> and *In re Mathews*<sup>4</sup>, argued that “the fact that an application has named a different inventive entity that a patent does not necessarily make that patent prior art.” The key word is “*necessarily*”. Although, applicant’s statement is true, it is not so at all times and in all situations.

The present application was on filed on September 30, 1998 as a continuation of US application 08/852,119 filed on May 6, 1997. The present application names only one inventor, Martin Kelly Jones and is assigned to Global Research System, Inc.

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<sup>1</sup> See response at page 12

<sup>2</sup> See response at page 12

<sup>3</sup> See response at page 12

<sup>4</sup> See response at page 12



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The claims of the present application are rejected as being anticipated US Patent 5,564,770 issued to John Ross. The '770 patent names only inventor, John Ross, and is assigned to Worldwide Notification Systems, Inc.

US Patent 5,648,770 issued on July 15, 1997, is a continuation of US patent application 08/307,032, which matured as US patent 5,444,44, and which in turn is a continuation of US application 08/062,405, filed on May 14, 1993 which is now abandoned. Thus, the '770 patent has an effective filing data of May 14, 1993.

In reference to *Applied Material Inc. v Gemini Research*<sup>1</sup>, the examiner agrees. *However, if the patent has an earlier US effective filing date than the application, such patent is considered to be prior art.* In the present case, the present application as filing date of May 6, 1997, while the prior art references have an effective US filing date of may 14, 1993.

The situation in *In re DeBaum* only applies to the same applicant for the patent and the application. By same applicant, it's meant the same inventive entity. In the present case, the present application names only Martin Kelly Jones, while the applied patents name only John Ross.

As to In re Mathews, one major difference between the present applicant and the *In re Mathews*' case is that Dewey and Mathews were co-workers. In the present case, there is no showing (other than applicant's statement) that applicant and Ross were co-workers. In fact, let it be known that the US patents to Ross, which named only one inventor, Mr. John Ross, are assigned to Worldwide Notification Systems, Inc. and the

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present application, which names only one inventor, Mr. Martin Kelly Jones, is assigned to Global Research systems, Inc.

Applicant can file an affidavit to overcome the rejection. However, this can only happen in the case where i) applicant is one of a group of inventors of the patent or ii) the application and the patent are assigned to the same assignee. In the present case, the present application names only one inventor, Martin Kelly Jones and the '770 patent name only one inventor, John Ross. In order for condition i) above to apply, the '770 patent in question must have Martin Kelly Jones as one of its inventors. In addition, the present application is assigned to Global Research Systems, Inc. while the '770 patent is assigned to Worldwide notification Systems, Inc. In the case of the present situation, the patent applied against the claims of the present application Ross [5,648,770], both of which names only one inventor John Ross and is assigned to Worldwide Notifications Systems, Inc. Therefore, neither condition i) nor condition ii) applies.

Applicant submitted a plurality of exhibits in support to show that the subject matter disclosed by Ross and used in the office action to reject the claims is the product of applicant's own previous work. Applicant then asserts that the Ross patent is not prior art.

The mere fact that applicant has submitted several exhibits including a declaration filed by applicant stating that applicant is a "co-inventor" of the patents to Ross and that applicant invented the subject matter disclosed in the patents to Ross, is not a basis to remove the Ross patents as prior art and withdrawn the rejections.

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The examiner has considered and reviewed all the documents (exhibits) presented before him. However, based on the limited information presented herein, the examiner is not able to make a decision as to withdrawn the rejections. Applicant would need a disclaimer from Mr. Ross and/or the assignee of the Ross patents affirming that applicant's statement is true or any other evidence showing such.

As to the essence of the rejection itself, applicant argued that the '770 patent to Ross does not disclose all the limitations of the claimed invention. Applicant contended that the '770 patent does teach the request from the user to activate the system.

Notwithstanding applicant's arguments, the examiner has applied a new ground of rejection against the claims as such limitations argued by applicant have been added by way of this amendment.

Accordingly, the claims remained rejected and this office action is made final.

### *Conclusion*

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Trask, US Patent 5,945,919, discloses a dispatcher free vehicle allocation system, wherein the system answers dispatch requests for service from customers within the operational area. The system receives the requests from the users or customers and transfers a message or response to the users or customers. See for example figures 2, 5, and 6, columns 1-5.

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- Culbertson, US Patent 5,799,263, discloses a public transit system and apparatus and method for dispatching public transit vehicles, wherein the system receives a request from a user and sends/transmits a message back to the user.
- James, US Patent 5,420,794, discloses an automated highway system for controlling the operating parameters of a vehicle.

The aforementioned prior art references are very pertinent to applicant's claimed invention. Applicant is suggested to carefully consider these references in response to this office action.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacques H. Louis-Jacques whose telephone number is (703) 305-9757. The examiner can normally be reached on M-Th, 8:30 AM - 5:00 PM (Eastern Time).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Cuchlinski can be reached on (703) 308-3873. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-8623 for regular communications and (703) 308-8623 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1111.

Jacques H. Louis-Jacques  
Primary Examiner  
Art Unit 3661

/jlj  
September 1, 2000

*Jacques H. Louis-Jacques*  
JACQUES H. LOUIS-JACQUES  
PRIMARY EXAMINER